REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 15-26 are now present in this application. Claims 15-18 are independent. By this Amendment, claims 8-14 are canceled, claims 15-17 are amended, and claims 18-26 are added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Election/Restriction/ Lack of Unity of Invention

Applicant continues to traverse the holding of lack of unity of invention and withdrawal of method claims 15-17 from consideration and examination on their merits, notwithstanding the Group Director's decision on petition, dated March 19, 2010, and reserves the right under 37 CFR §1.144 to file a further petition to the Commissioner to act in his supervisory capacity to overturn that decision on petition. Applicant notes that, by the express terms of 37 CFR §1.144, such a petition is timely if filed prior to the taking of an appeal in this application.

Applicants notes, in this regard, that MPEP §1893.03(d) clearly states that "an apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative process or means."(emphasis added).

The Group Director has to follow the MPEP, and the MPEP clearly does not require a "special technical feature" be commonly recited in the different statutory categories. Instead, it only requires that a "technical relationship" be commonly recited for unity of invention to exist.

Accordingly, unity of invention exists between the method and apparatus claims and claims 15-17 should be examined on their merits in the next Office Action.

Rejections under 35 USC §102

Claim 8 stands rejected under 35 USC §102(b) as being anticipated by JP 01-234024 ("JP '024"). Claims 8 and 9 stand rejected under 35 USC §102(b) as being anticipated by JP 61-190866 ("JP '866"). Claims 8-13 stand rejected under 35 USC §3,976,506 to Landau. These rejections are respectfully traversed as moot because claims 8-13 have been canceled.

New Claims 8-16

Applicant respectfully submits that claims 8-16 patentably define over the aforementioned applied art for reasons presented below.

New, independent, claim 18 recites a system for protection of high temperature fuel cells in mobile systems, said fuels cells being subject to load variations of more than five percent over a period of one hour, comprising: at least one high temperature fuel cell that uses fuel other than only hydrogen; at least one buffer for storage of surplus energy, arranged to function as a regulating system between the high temperature fuel cell and a energy consumption unit; and a device for dumping energy which is required to be led out of the system when the buffer is full

or according to need; the system comprising:- a device for storing energy which is produced by said high temperature fuel cells, and which is not used by the system, in said buffer; a device for using energy stored in said buffer at the need for more energy in said system than the high temperature fuel cell can deliver momentarily; and a device for dumping energy which can not be stored in said buffer, or which is required to be removed momentarily when loosing a energy consumption unit, by said dumping device; wherein the mobile fuel cells function as a producer of electric energy while being subject to load variations of more than five percent over a period of one hour.

With respect to according patentable weight to the claim preamble, Applicant continues to believe that the *Kropa v. Robie* decision supports according patentable weight to the claim preamble for reasons previously presented in the amendment filed on November 2, 2009, which reasons are incorporated herein by reference thereto. Moreover, where, as here, a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed.Cir. 1989).

Additionally, claim 18 recites the subject matter of the claim preamble not only in the claim preamble, but also in a wherein clause in the body of the claim itself. Applicants refer the Examiner to Akamai Technologies Inc., v. Cable & Wireless Internet Services Inc., 68 USPQ2d 1186 (Fed. Cir. 2003), where patentable weight was given to the "wherein" clause without question. Similarly, in Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002), the court held that the wherein clause limits the subject matter in issue. Applicants respectfully submit that the wherein clause recites features that are not otherwise inherent in the claim and that are used to patentably define the invention. Applicants respectfully submit that the wherein clause has to be

given patentable weight and that none of the applied art discloses the positively recited features in the wherein clause

Applicant respectfully submits that none of the applied art discloses the features recited in both the claim preamble and in the body of the claim. More specifically, Applicant respectfully submits that none of the applied art discloses a system for protection of high temperature fuel cells in mobile systems wherein the mobile system fuel cells function as a producer of electricity while being subject to load variations of more than five percent over a period of one hour.

With respect to JP '024, Applicant respectfully submits that JP '-24 does nor disclose the claim preamble features and instead, is directed to a simple DC power storage system that uses low temperature fuel cells that do not have the characteristics of Applicant's claimed high temperature fuel cells or a load variation system for protection of high temperature fuel cells that are subject to load variations of at least thirty percent over a period of 15 seconds, as claimed.

With respect to JP '866, applied as an anticipatory reference, Applicant respectfully submits that this reference also fails to disclose Applicant's claimed high temperature fuel cells or a load variation system for protection of high temperature fuel cells that are subject to load variations of at least thirty percent over a period of 15 seconds, as claimed.

Additionally, Applicant respectfully submits that JP '866, applied as an anticipatory reference, does not disclose a buffer or storage at all, let alone, as claimed. As Applicant understands the English language translation of JP '866, upon which the rejection is based, the load is element 20, and element 15 is not a buffer for storage of surplus energy, but is merely an

alternate load to the load 20 to prevent generation of excessive voltage by the fuel cell electrodes.

With respect to Landau, applied as an anticipatory reference, Applicant respectfully submits that this reference also fails to disclose Applicant's claimed high temperature fuel cells or a load variation system for protection of high temperature fuel cells that are subject to load variations of more than five percent over a period of one, as claimed.

Additionally, Landau's boiler 20 is not a storage, or a buffer for storing, of surplus energy, arranged to function as a regulating system between the fuel cell and an energy consumption unit, as claimed. In Applicant's invention, the buffer. which may be a boiler, is a separate element from the fuel cell that is between the fuel cell and the receiver of the fuel cell energy. This differs from Landau, whose boiler 20 is an integral element of the power plant and is used simply to heat water to steam.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention recited in claims 18-26.

With respect to the three alternative reference combinations, i.e., Landau in view of either JP 10-334936 ("JP '936") or U.S. Patent 4,622,275 to Noguchi, or U.S. Patent 5,482,791 to Shingai, Applicant respectfully that none of these reference combinations render obvious the claimed invention.

Applicant respectfully submits that Landau fails to disclose the invention recited in claim 18 for reasons set forth above. and that none of the auxiliary references are applied to remedy the shortcomings of Landau with respect to the claimed invention.

So, even if one of ordinary skill in the art were (for sake of argument only) properly motivated to modify Landau in view of any of the three alternatively applied auxiliary references, the so-modified version of Landau would still not disclose, suggest, or otherwise render obvious the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in claims 18-26.

Thus, consideration and allowance of claims 18-26 are respectfully requested.

CONCLUSION

In view of the foregoing claim amendments and remarks, Applicant respectfully requests that the holding of lack of unity of invention and the election of species requirement be withdrawn, that claims 15-17 be examined on their merits, and that all pending claims be allowed.

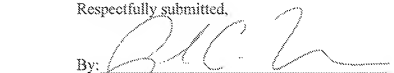
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 2, 2010

Respectfully submitted,

By: 

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